

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and the following remarks are presented for the Examiner's consideration.

Claims 1-5 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,587,684 to Hsu et al. (hereinafter "Hsu") in view of U.S. Patent Application Publication No. 2002/0065066 A1 to Takagaki (hereinafter "Takagaki") and in further view of U.S. Patent No. 6,073,075 to Kondou et al. (hereinafter "Kondou et al."). For the following reasons, the rejection is respectfully traversed.

Regarding claim 1, the Examiner states that "Hsu did not explicitly teach the downloaded data been an audio data (music data) and application software expressly to play music data on portable telephone and recording a history of the downloaded data items." Thus, the Takagaki reference is cited for teaching these limitations.

Applicant respectfully submits that there is insufficient motivation for one of ordinary skill in the most relevant art to modify the teachings of Hsu on the basis of the Takagaki reference. There is nothing in Hsu that suggests modifying its digital telephones to receive or store music data, as required. There is no mention of music or music application software anywhere in Hsu. The Examiner states that an "artisan working with Hsu's invention would have been motivated to look for teachings that may have allowed a user to select or specify a music data to be downloaded and reproduced on the mobile station by selecting a music data from a large number of music data and to specify the reproduction order of the selected music data." Applicant respectfully submits that Examiner's "motivation" is merely a conclusory statement with no basis in the prior art. Applicant further submits that the skilled artisan working with Hsu

would not be looking for teachings relating to downloading music data, since there is nothing taught or suggested regarding music data in Hsu.

The Examiner is respectfully reminded that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (MPEP § 2143.01). Further, the Examiner is reminded that "The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (MPEP § 2142). Applicant further notes that, while mobile telephones containing music data reproducing software may be commonplace today, the obviousness of the combination must be considered at the time the present invention was made. Applicant respectfully submits that, prior to August 20, 1999, the earliest date of invention established in the present application, it would not have been obvious to combine Hsu and Takagaki as the Examiner suggests.

For all of the reasons stated above, no *prima facie* case of obviousness can be made in support of the rejection under 35 U.S.C. 103(a). If the Examiner intends to maintain the rejection, Applicant respectfully requests that the Examiner indicate where support for the obviousness of the proposed combination can be found *in the prior art*.

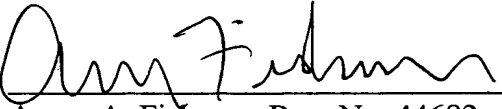
In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 09/642,622
Amdt. Dated September 16, 2004
Reply to Office action of May 17, 2004

If there are any additional fees resulting from this communication, please charge same
to our Deposit Account No. 16-0820, our Order No. 32893.

Respectfully submitted,

PEARNE & GORDON LLP

By: 
Aaron A. Fishman, Reg. No. 44682

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: September 16, 2004